

### REMARKS

Reconsideration of the application is requested in view of the modifications above and the remarks below. Applicants have cancelled Claims 3-6. Claim 1 has been amended to add the limitation that was in Claim 3. The above-mentioned amendments have been made to place the application in condition for allowance or in better form for appeal.

#### Rejection Under 35 USC 102

The Office Action rejected Claims 1, 3-4 and 10-12 under 35 USC 102 as being unpatentable over Tetenbaum et al. The rejection should be withdrawn in view of the remarks below.

It is well settled that in order for a prior art reference to anticipate claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in prior art. The disclosure requirement under 35 USC 102 presupposes knowledge of one skilled in art of claimed invention, but such presumed knowledge does not grant license to read into prior art reference teachings that are not there. See Motorola Inc. v. Interdigital Technology Corp. 43 USPQ2d 1481 (1997 CAFC).

Applicants' invention is related to powdered thickener-preparation produced by forming a solution, suspension or melt of a mixture comprising,

- a) at least one urethane group-containing, water-soluble or water-dispersible thickener,
- b) at least one water-soluble substance solid at room temperature
- c) optionally a non-ionic, aromatic or aliphatic emulsifier and
- d) optionally other auxiliary substances and subsequently converting the products obtained into powder form by drying or grinding.

The ready-to-use preparations according to Applicants' invention represent solid mixtures which do not agglomerate during storage. Their shelf life is generally at least as long as that of a corresponding liquid preparation. The stabilizing agents (clay compounds) of Tetenbaum et al. are not water-soluble. Therefore the clay of Tetenbaum et al. does not fall within the scope of b) of the amended Claim 1. An advantage of the preparation according to Applicants' invention is that they can be

used for aqueous paints and lacquers. Reconsideration is requested. Tetenbaum does not each and every element of the invention encompassed by Claim 1 with sufficient clarity to prove Applicants' invention existed in the prior art. Reconsideration is requested.

Rejection Under 35 USC 103

The Office Action rejected Claims 1-21 under 35 USC 103(a) as unpatentable over Tetenbaum et al in view of Kanou et al and Smith. The rejection should be withdrawn in view of the remarks below.

It is well established that to establish a *prima facie* case of obviousness, the USPTO must satisfy all of the following requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Second, the proposed modification must have had a reasonable expectation of success, as determined from the vantage point of one of ordinary skill in the art at the time the invention was made. *Amgen v. Chugai Pharmaceutical Co.* 18 USPQ 2d 1016, 1023 (Fed Cir, 1991), *cert. denied* 502 U.S. 856 (1991). Third, the prior art reference or combination of references must teach or suggest all of the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496, (CCPA 1970). The Office Action did not establish a *prima facie* case of obviousness.

Applicants' invention is related to powdered thickener preparation produced by forming a solution, suspension or melt of a mixture comprising,

- a) at least one urethane group-containing, water-soluble or water-dispersible thickener,
- b) at least one water-soluble substance solid at room temperature
- c) optionally a non-ionic, aromatic or aliphatic emulsifier and
- d) optionally other auxiliary substances and subsequently converting the products obtained into powder form by drying or grinding.

The ready-to-use preparations according to Applicants' invention represent solid mixtures which do not agglomerate during storage. Their shelf life is generally at least as long as that of a corresponding liquid preparation.

One of ordinary skill in the art following the teachings of Tetenbaum would not have been motivated to modify Tetenbaum et al. and make Applicants' invention.

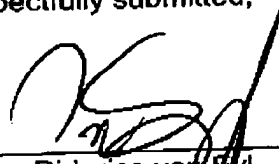
As discussed above, the stabilizing agents (clay compounds) of Tetenbaum et al. are not water-soluble. Therefore the clay of Tetenbaum et al. does not fall within the scope of b) of the amended claim 1. An advantage of the preparation according to Applicants' invention is that they can be used for aqueous paints and lacquers. With such teachings, Tetenbaum would not have taught Applicants' invention. Reconsideration is requested.

With respect to Smith or Kanaou, these references do not overcome the deficiencies of Tetenbaum et al. Also Smith and Kanou et al. do not suggest the use of solid and water-soluble substances for the preparation of a thickener. With the teachings of Tetenbaum et al, singly or in combination with Smith and Kanou, the artisan would not have been motivated to make Applicants' invention.

In view of the foregoing amendments and remarks, allowance of all the pending claims is earnestly requested. .

Respectfully submitted,

By



Diderico van der Lijde  
Attorney for Applicants  
Reg. No. 38,641

LANXESS Corporation  
111 RIDC Park West Drive  
Pittsburgh, Pennsylvania 15275-1112  
(412) 809-2231  
FACSIMILE PHONE NUMBER:  
(412) 809-1054

/jme

S:\Chem Pittsburgh\Law Shared\SHARED\DVE\PATENTS\6803\6803 Response.doc

Mo 6803

-6-